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## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

<b>FACSIMILE TRANSMITTAL COVER SHEET</b>	<b>Application Number</b>		10/661,760 <del>75 14</del>
	<b>Filing Date</b>		September 12, 2003
	<b>First Named Inventor</b>		Jeong J. MA
	<b>TITLE</b>	COMMUNICATION HEADSET AND METHOD	
	<b>Art Unit</b>		2642
	<b>Examiner Name</b>		Jack CHIANG
	<b>Attorney Docket Number</b>		MOT-CS22547RL

<b>TO: USPTO</b>	<b>Fax Number:</b> 571-273-8300
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<b>ENCLOSURES</b>	
<b>Description</b>	<b># of pages</b>
Notice of Appeal	1
Credit Card Payment Form	1
Pre-Appeal Brief Request for Review	1
Statement in Support of Request for Pre-Appeal Brief Review	4
<b>Total number of pages in this submission (including this page):</b>	
8	

<b>Signature of Applicant, Attorney or Agent</b>	
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<b>Signature</b>	
<b>Date:</b>	November 9, 2005

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<b>Signature:</b>	<b>Date:</b> November 9, 2005

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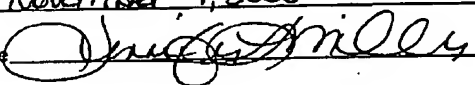
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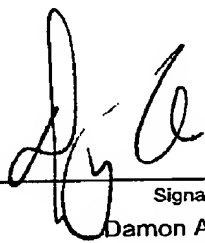
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/661,760	September 12, 2003
		First Named Inventor	
		Jeong J. MA	
Art Unit		Examiner	
2642		Jack CHIANG	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,964</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Signature  
Damon A. Neagle

Typed or printed name

610-395-4900

Telephone number

November 9, 2005

Date

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## IN THE UNITED STATES PATENT &amp; TRADEMARK OFFICE

<b>STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF REVIEW</b>	Application Number	10/661,755
	Filing Date	September 12, 2003
	First Named Inventor	Jeong J. MA
	TITLE	COMMUNICATION HEADSET AND METHOD
	Confirmation Number	8148
	Group Art Unit	2642
	Examiner Name	Jack CHIANG
	Attorney Docket Number	MOT-CS22547RL

To: Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Applicant respectfully requests a pre-appeal brief review of the final rejection mailed from the Office on August 9, 2005.

**REMARKS**

Claims 1-23 are pending in the application and all stand rejected. Claims 1-2, 4-7, 10-16, 19 and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by Bodley (U.S. Pub. No. 2002/0021800, Pub. date February 21, 2002). Claims 3, 8-9, 17-18, 20 and 22-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bodley et al.

All of the pending independent claims, including claims 1, 11, 20 and 21, recite variations on a structure that turns power to the headset off and on in response to the position of an ear mount. The Examiner asserts that Bodley et al. discloses a switch (102) that is responsive to the open and closed positions of the ear mount (6) and controls a circuit (19) that activates and deactivates the circuit (19). This ground of rejection is based on an erroneous reading of Bodley et al. and does not support a prima facie rejection under §102(b).

As explained in our Reply filed on May 27, 2005, the switch (102) referred to by the Examiner is not responsive to the position of the ear mount (6). The switch (102) is only responsive to the position of the microphone arm (2) (see paragraphs [0079] [0080]). In paragraph 5 of the August 9, 2005 Office action, the Examiner makes the argument the fact that

rotating the earhook and boom at the same time would activate or deactivate the power switch (102) reads on the claimed limitation. Given that there is no teaching or suggestion that rotating the boom (2) would cause the earhook (6) to also rotate, there is no functional connection between rotation of the earhook (6) and the power switch (102), as required by independent claims 1, 11, 20 and 21. Therefore, the factual basis for the §102(b) rejection is flawed.

Even if there were such a teaching in Bodley et al., the circuit (19) does not activate or deactivate the headset (1), as required (in various forms) by each of the pending independent claims of this application. Circuit (19) is a microphone (see Bodley et al. paragraphs [0055] and [0056]) and does not appear to activate or deactivate the headset (1). Therefore, the facts set forth in by the Examiner do not support a prima facie rejection under §102(b).

Based on the foregoing, the Examiner's rejection of claims 1-2, 4-7, 10-16, 19 and 21 under 35 U.S.C. §102(b) should be withdrawn.

The Examiner's rejections under 35 U.S.C. §103(a) are based on two premises: (1) that it would be obvious to modify Bodley et al. to enable power to the headset to be turned on and off in response to the position of the ear mount (6), instead of the microphone arm (2), as taught by Bodley et al., and (2) that Bodley et al. teaches a detent mechanism for positioning and releaseably holding the ear mount in an open position and a closed position. Both of these conclusions are factually inaccurate.

In support of the assertion that it would have been obvious to modify Bodley et al. to enable power to the headset to be turned on and off in response to the position of the ear mount, the Examiner asserts that such a modification would be obvious to one of ordinary skill in the art because it involves merely "shifting location of parts" and cites In re Japiske, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) in support of this conclusion. This characterization of the modifications

necessary to arrive at the claimed invention is erroneous. The modification suggested by the Examiner would substantially change the operation of Bodley et al.'s headset. Bodley et al. teaches a switch (114) that changes the orientation of buttons (108-112) depending upon whether the ear mount (6) is in a left ear or right ear position (see paragraph [0062]). Modifying Bodley et al. to provide a power switch that is responsive to the position of the ear mount would destroy this functionality, which is an important feature of the Bodley et al. device (see paragraph [0017]). In addition, having a power switch that is responsive to the position of the earhook (6) provides a different and improved functionality than providing a power switch that is responsive to the position of the microphone arm (2). For example, unlike the microphone arm (2), the earhook (6) cannot be rotated into a closed position when the headset (1) is in use on a user's ear. This reduces the possibility of accidentally deactivating the headset (1) during a call. Clearly, shifting the power switch (102) so that it is responsive to the position of the ear mount (2), would require much more than a mere "shifting of parts."

Claims 4-8, 13-16 and 20 recite a detent mechanism for positioning and releaseably holding the ear mount in an open position and a closed position. Claims 5 and 6 further define the angular location of the open position relative to the closed position. Contrary to the Examiner's assertion, Bodley et al. clearly does not teach this limitation.

The Examiner merely refers to FIG. 7, in which the earhook 6 is shown in a partially open position, to support the assertion that Bodley et al. teaches the detent mechanism limitation recited in claims 4-8, 13-16 and 20. FIG. 7 is insufficient to support a rejection of the detent mechanism claim limitation. There is no discussion in the specification of Bodley et al. of the desirability of a detent mechanism that holds the earhook 6 in the position shown in FIG. 7. In fact, paragraph [0064] of Bodley et al. specifically states that recesses 144, 146, 148, 150) are

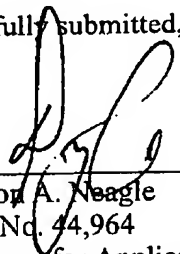
designed to "insure that the earhook 6 collapses against the body 1." Moreover, the orientation of the detent mechanism structure disclosed in Bodley et al. (see 148, 150 in FIG. 13) is only capable of biasing the earhook (6) into a fully closed position. Therefore, the detent mechanism of Bodley et al. clearly does not hold the ear mount in an open position or in more than one position, as required by claims 4, 13 and 20.

In further support of this position, the Examiner states in paragraph 5 of the August 9, 2005 Office action to "(note: check also the real product sold in the market)." This justification for maintaining a prior art rejection is completely inappropriate. The "real product sold in the market" is not of record in this application, and therefore, cannot serve as the justification for a rejection. More importantly, it is very likely that the "real product on the market" to which the Examiner refers is actually the Applicant's product, not that of the applicant in Bodley et al.

In view of the foregoing, withdrawal of the Examiner's rejections under §103(a) is respectfully requested.

Respectfully submitted,  
MA

By

  
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Date: November 9, 2005

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